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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,492	09/25/2000	Thierry Ifergan	64875	3091

7590 06/18/2003  
DOWELL & DOWELL, P.C.  
SUITE 309  
1215 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202-3124

EXAMINER

MAI, HUY KIM

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	Application No. 09/669,492	Applicant(s) IFERGAN ET AL.	
	Examiner Huy K. Mai	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,6-8 and 10-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-8 and 10-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
       Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
       If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
       a) ☐ All    b) ☐ Some \* c) ☐ None of:  
           1. ☐ Certified copies of the priority documents have been received.  
           2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
           3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
       \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
       a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1,8,10,11,13-18,21-23,25 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Zider (6,139,141).

The limitations in claims 1,8,10,11,13-18,21-23,25 are shown in Zider's Figs. 1-7, column 2, lines 48-52 and column 3, line 42 through column 5, line 53. Zider explicitly discloses an eyeglass device comprising two temporal members 12, a primary eyeglass frame 10 having means for holding a first set of lens therein, said primary eyeglass frame including a first bridge, two side portion, each having a first temporal extension 11 for connecting to a temporal member, each said first temporal extension including a first magnet 31 attached thereto, an auxiliary

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eyeglass frame 20 including a second bridge, two side portion, each having a second temporal extension 21, each said second temporal extension including a second magnet 30 attached thereto, wherein the first magnets 31 magnetically engage respectively second magnets 30 in overlying relation so as to secure said auxiliary eyeglass frame to said primary eyeglass frame and wherein the second bridge is comprised of a flexible shape memory alloy.

3. Claims 10,11,16-18,21-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Se (JP9-138374).

The limitations in claims 10,11,16-18,21-23 are shown in Se's Figs. 1-8. Se discloses an eyeglass device wherein the second bridge of the auxiliary eyeglass frame is comprised of a flexible shape memory alloy.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3,12,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zider.

As to claims 3,12,24, Applicant admits on page 3 of the specification, in lines 18-20, that typical flexible shape memory alloy of the art are NiTi or CuAlBe, therefore, it would have been obvious to a person of ordinary skill in the art to use a flexible shape memory NiTi alloy of Zider, as is conventional. Thus, claims 3,12,24 would have been obvious over Zider under 35 USC 103.

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6. Claims 19,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zider in view of Masugana (5,431,506).

Zider does not disclose the temple members and the temporal extensions being a flexible material. The temple members and the temporal extensions made from a flexible material are well known in this art as taught by Masugana, for example. Those of ordinary skill in the art at the time the invention was made would find it obvious to make the temple members and the temporal extensions of Zider reference by a flexible material.

7. Claims 4,6,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zider in view of Masugana (5,431,506).

Zider discloses the claimed invention as discussed above. He also suggests in column 5, lines 49-51, the magnets could be below the side portion (the end piece) of the primary eyeglass frame. Zider does not disclose the temple members and the temporal extensions being a flexible material. The temple members and the temporal extensions made from a flexible material are well known in this art as taught by Masugana, for example. Those of ordinary skill in the art at the time the invention was made would find it obvious to make the temple members and the temporal extensions of Zider reference by a flexible material.

8. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1,3,4,6-8,10-25 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy K. Mai whose telephone number is (703) 308-4874. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

HKM/  
June 13, 2003

A handwritten signature in black ink, appearing to read 'Huy Mai', enclosed within a circular outline.

Huy Mai  
Primary Examiner